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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,361	03/22/2000	Beatrice Tourni	6388-0501-0	9261
22850 7590 03/16/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER YU, GINA C				
ART UNIT		PAPER NUMBER		
1611				
NOTIFICATION DATE		DELIVERY MODE		
03/16/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/533,361

Applicant(s)

TOUMI ET AL.

Examiner

GINA C. YU

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 18, 19, 24-29, 31-33, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 18, 19, 24-29, 31-33, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2009 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 18, 19, 24-29, 31-33, 48, and 49 are rejected as unpatentable under 35 U.S.C. § 103 (a) over Kumar et al. (US 5468477).

Kumar teaches a face cream composition comprising 2 % by weight of a vinyl-silicone graft polymer represented by the formula and constituents of col. 4, line 50 – col. 6, line 16. See Example 27. In the mercapto functional silicone compound shown in col. 8, line 30 – col. 9, line, when R1, G5, and G6 of the Kumar polymer is C1-4 alkyl, the prior art meets G1 of instant formula (IV); R2 and R4 of the Kumar polymer being C1-10 alkylene meets G2 of instant formula (IV) when n = 1; G2 and G4 of the prior art is vinyl polymeric segments consisting essentially of polymeric free radically polymerizable monomer, meet G3 and G4 of instant claim. Example 2 teaches copolymer using mercapto functional silicone (PS850), acrylic acid (anionic monomer of

G3 of instant claims) and n-butyl methacrylate (hydrophobic monomer of G4 of instant claims). The reference teaches that the polymer is used in cosmetics having active ingredients such as "skin-improvers". See col. 25, lines 10-29. The vinyl-silicone copolymers are used to make a gel composition, and said to also have "excellent film-forming capability", exhibiting a superior water-resistance, oil-resistance, and other characteristics required for cosmetic films". See col. 17, line 30 – col. 18, line 24. The reference also teaches using preferably 0.2-30 % by weight of vinyl-silicone copolymer to realize the desired cosmetic film property. See col. 43—50. See also col. 17, lines 56-66; col. 19, lines 4-13. See instant claims 19, 25, 26, and 31-33. Kumar further suggests that the grafted vinyl-silicone copolymer gives a good adhesion to a substrate and retains its shape-retention property in virtue of the hard monomers which renders the grafted copolymers tensile strength. See col. 15, line 47- col. 16, line 14; col. 18, lines 19-64. See also col. 19, line 14 – col. 23, line 5 which specifically teaches the prior art silicone graft copolymers can be formulated into skin cosmetics which provides improved water-resistance, good spreadability on the skin, and a "thick-film sensation" after the application.

It would have been obvious to one of ordinary skill in the art at the time the invention was modified the teachings of Kumar by incorporating the vinyl-silicone graft polymers of Kumar to skin treatment composition as motivated by the teachings of the reference because the latter teaches that the vinyl-silicone polymer renders "excellent film-forming capability", superior resistance to water and oil, "thick-film sensation" and otherwise suitable for cosmetic films. The skilled artisan would have had a reasonable

expectation of successfully producing a skin tightening composition with superior or equivalent film-forming effect on the skin because Kumar illustrates skin treatment compositions in the form of gel, lotion, and cream formulations using the obvious variants of the silicone-vinyl grafted polymers.

Response to Arguments

Applicant's arguments filed on January 12, 2009 have been fully considered but they are not persuasive.

Applicant asserts the vinyl silicone copolymer of Kumar's example 27 fails to meet the present claims because the prior art polymer contains ethylhexyl methacrylate and butyl methacrylate of example 3. However, applicant's polymer is taught in example 2, which contains acrylic acid (anionic monomer of G3 of instant claim) and n-butyl methacrylate (hydrophobic monomer of G4 of instant claim) and the present claim limitations are within the prior art disclosure as explained in the rejection. Examiner respectfully points out a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. See Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Applicant's argument regarding application of the Fox reference (US 5879684) is moot, as the rejection has been withdrawn.

Applicant asserts the application of the Kumar's film-forming polymers is limited to making hair treatment compositions. The argument is unpersuasive, as the reference illustrates numerous examples of skin treatment products using the prior art vinyl

silicone polymers and devotes a separate section of the reference to teach how to use the polymers in skin care cosmetics.

Applicant asserts the declaration filed under the Rule 132 on May 14, 2008 overcomes any case of prima facie case of obviousness. In the declaration, a comparison test was conducted to compare the tensioning effects of a grafted silicone copolymer which is within the present invention (polydimethyl siloxane having propyl thio-3 methyl acrylate/methyl methacrylate/methacrylic acid copolymer) and comparative non-grafted silicone copolymers. While the data indicates the grafted copolymer showed a superior tensions/tightening effect, examiner views the Kumar teachings render the result of the comparison test obvious. The reference indicates the prior art grafted vinyl-silicone copolymer gives a good adhesion to a substrate and retains its shape-retention property in virtue of the hard monomers which renders the grafted copolymers tensile strength. Thus a good tensile strength of the Kumar copolymer when applied to skin is already expected. The comparison test of the different copolymers in present declaration shows that the Kumar copolymer has a better tensile strength than non-grafted silicone copolymers, but fails to show that the results are unexpected or surprising against the prior art teaching.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605.

The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Primary Examiner, Art Unit 1611